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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/647,899	12/21/2000	Werner Taubmann	40551/DBP	6061

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EXAMINER

STRIMBU, GREGORY J

ART UNIT	PAPER NUMBER
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3634

DATE MAILED: 09/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/647,899

Applicant(s)

TAUBMANN ET AL.

Examiner

Gregory J. Strimbu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2003 and 10 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) 3,5,25 and 34-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6-24,26-33 and 43-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 13 January 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Election/Restrictions

Applicant's election of Group I in Paper No. 14 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Accordingly, claims 3, 5 and 25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 14.

Drawings

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on January 13, 2003 have been approved.

Claim Rejections - 35 USC § 112

Claims 9, 10, 11, 14, 15-23, 26-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Recitations such as "the raised area" on line 2 of claim 9 render the claims indefinite because it is unclear which one of the plurality of raised areas set forth above the applicant is referring to. Recitations such as "running conical" on line 2 of claim 10 render the claims indefinite because it is unclear what the applicant is trying to set forth. Recitations such as "the assembly direction" on lines 2-3 of claim 10 render the claims

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indefinite because they lack antecedent basis. Recitations such as "to same" on line 4 of claim 15 render the claims indefinite because it is unclear what element of the invention "same" is referring to. Recitations such as "type" on line 3 of claim 16 render the claims indefinite because it is unclear what the applicant is attempting to set forth. How much like a box profile guide rail assembly must an object be before it can be characterized as a "box profile type guide rail assembly"? Recitations such as "its ends" on line 7 of claim 16 render the claims indefinite because it is unclear what element of the invention the applicant is referring to.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 6-15, 24, 26 and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Weber. Weber discloses a drive for adjusting devices in motor vehicles comprising one of a fixed spindle and a fixed toothed rack 11 fixed on one of two relatively displaceable parts, a gear assembly 15, 30 mounted on the other of the two relatively displaceable parts, and a gear housing holding the gear assembly, with the gear housing having at least two housing plates 1 and 2 which can be fixed against each other by plug in connectors 8, 10 each plug in connector comprising a plug at one of the at least two housing plates and a receptacle for the plug at the other of the at

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least two housing plates, and the plug in connector is connected by plugging the plug into a respective one of the receptacles, wherein the plug in connectors are formed sufficiently rigid to fix the at least two housing plates relative to each other in all three dimensional directions and to form supporting connecting joints which absorb gear forces and wherein the at least two housing plates are fixed relative to each other solely at the plug-in connectors.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-23 and 44-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber as applied to claims 1, 2, 4, 6-15, 24, 26 and 43 above, and further in view of Isomura. Isomura discloses a gear housing 83 mounted in a U-shaped gear socket 46 of a holder.

It would have been obvious to one of ordinary skill in the art to combine the teachings of Weber and Isomura, to reduce the cost of manufacturing of the invention of Isomura.

Claims 27-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber as applied to claims 1, 2, 4, 6-15, 24, 26 and 43 above. Although Weber is silent

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concerning the particular method of manufacturing of drive, the construction of the drive of Weber would inherently lead to the method steps as set forth in claims 27-33.

Response to Arguments

Applicant's arguments filed August 4, 2003 have been considered but are not persuasive.

With respect to the applicant's argument concerning Weber, the examiner respectfully disagrees. WEBSTER'S II NEW RIVERSIDE UNIVERSITY DICTIONARY 483 (1994) defines the term "fix" as "to fasten or place securely". Therefore, the plug in connectors 8 and 10 of Weber fix the two housing plates relative to each other in all three dimensional directions since they securely fasten the connectors 8 and 10 of Weber in all three dimensional directions. Although the resilient nature of the connector 8 may allow for some movement of the housing plates relative to one another, the plug in connectors 8 and 10 still sufficiently rigid to fix the two housing plates to one another because they securely fasten the two housing plates together. Note that the applicant has only claimed that the plug-in connectors are "formed sufficiently rigid to fix the at least to housing plates relative to each other". The applicant has not claimed that the plug-in connectors are rigid. With respect to the applicant's comments concerning the connecting element 11, the examiner respectfully disagrees. Lines 29-34 of Weber do not set forth that the connecting element connects the two housing plates together. Additionally, the end tabs 7 do not fix the two housing plates together. See column 3,

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lines 5-9 of Weber which set forth that the end tabs limit the insertion of the adjustment into the guide of the support from the rear side.

Conclusion

THIS ACTION IS NOT MADE FINAL.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is 703-305-3979. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3597 for regular communications and 703-305-3597 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.



Gregory J. Strimbu
Primary Examiner
Art Unit 3634
September 22, 2003